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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/035,380      | 11/01/2001  | Wayne Ellis Eccard   | 8766                | 2082             |

27752 7590 07/01/2004

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EXAMINER

YU, GINA C

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1617

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/035,380 | <b>Applicant(s)</b><br>ECCARD ET AL. |  |
|                              | <b>Examiner</b><br>Gina C. Yu        | <b>Art Unit</b><br>1617              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/11/02, 8/15/02, 3/24/03, 9/21/03</u> | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the term "an active ingredient comprising a surfactant" renders the claim vague and indefinite. Examiner views that one of ordinary skill in chemical art would understand that "an active ingredient" refers to a single compound. The limitation is confusing because it is not clear whether the ingredient itself is a surfactant or a composition comprising another active ingredient and a surfactant. For the examination purposes, examiner assumes that surfactant is the intended active ingredient in this case.

In claims 28 and 29, the phrase "less than about" and "greater than about" render the claims vague and indefinite. There is nothing in the specification to indicate as to what range of viscosity is covered by "about". The metes and bounds of the scope of the claims are not ascertainable because it is not clear whether "less than about 15 cP" covers, for example, 14.5 cP or 20 cP. The limitation is confusing because what viscosities are covered by "greater than about 15 cP" or "greater than about 10 cP". The scope of the claims is even more confusing in claim 29, where applicants recite that one has a viscosity of "less than about 15 cP" under the first Cold Water Insolubility Test, while it has a

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viscosity of "greater than about 15 cP" under the second Cold Water Insolubility Test. Should there be one viscosity value for both tests?

Similarly, the term "from about 1:8 to about 10:1" renders Claim 1 vague and indefinite because what is covered by "from about" 8 is uncertain. Does 1:7 or 1:6 meet the claim limitation? Claim 38 is rejected for analogous reasons.

Claim 22 is an incomplete claim.

The remaining claims are rejected as depending on indefinite base claims.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

<sup>1-7, 9-21</sup>  
Claims ~~1-21~~, 23-29, 31-33, 38-44 are rejected under 35 U.S.C. 102(b) as

being clearly anticipated by Rowe (US 2226075).

Claim 1 recites method of topically applying active ingredients to the hair or skin, said method comprising the steps of 1) applying to the hair or skin with a combination of water and a composition, said composition comprising a solid polymeric foam of the recited foam density, wherein said foam comprises solid polymer structurant and an active ingredient; and 2) rinsing the hair or skin.

Claim 40 recites method of cleansing by topically applying a lathering composition which disintegrates in water and then rinsing.

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Rowe discloses sheet soap comprising polyvinyl alcohol (polymeric structurant) and glycerol (a plasticizing agent) in the weight ratio of the instant claims. See Examples I-V. See also p. 2, first column, lines 5 – 15. See instant claims 1, 2, 23- 27, 31-33. See Example IV for the anionic surfactant, sulfated lauryl alcohol. See instant claim 25. The reference teaches that the layer of film has about 0.02 inch in thickness (0.51 mm). See *Id.*, at lines 58-60. See instant claim 7. The reference teaches that the sheet soap is readily soluble in water. See col. 1, lines 27 – 36. See instant claims 19 and 20.

For claims 3, the structure implied by the process of making the composition is considered. However, the final product of the claimed invention is anticipated by the prior art, and thus the claimed process of making is not given patentable weight in this case. See In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). Nevertheless, examiner notes that the prior art sheet soap is produced by mixing powered soap with a 5 % aqueous solution of the polyvinyl alcohol, stirring and heating to 70 °C, and then drying the composition, which meet the claimed process steps. See p. 2, first column, lines 50 – 61. Thus the claimed product-by-process is anticipated by the final product itself of the Rowe patent and the structure implied by the prior art process.

The viscosity limitation of the synthetic polymer structurant, polyvinyl alcohol in this case, is met since the physical property is inseparable from the compound. It is viewed that the physical properties of the claimed composition are inherently present in the prior art composition since it is made of the same

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components for same purposes. While Rowe is silent as to the physical properties of the composition (i.e., Wet Drape Value, Dry Drape Value, Total Lather Volume, Foam Density, Immersion Density, basis weight, etc) as recited in claims 1, 4-6, 9- 18, 22, these properties are inherent to the composition of the base claims which otherwise meet the structural limitations of the composition. See page 2, first column, lines 61 –67. For the textured surface limitation of instant claims 39, see Id, at second column, lines 25 – 27.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rowe, as applied to claims 1-21, 23-29, 31-33, 38-44 above.

While the reference discloses that the sheet soap has thickness of about 0.2 inches (0.51 mm), the reference fails to teach the recited thickness the instant claims.

It is well settled in patent law that merely changing the dimensional size of a known device is an obvious variation of the art, absent any different performance in the claimed invention. See In Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984). In this case, the claimed composition has different

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dimensional size with no criticality. The Rowe reference in fact teaches that the dimensional size is related to the supply amount of soap needed for the wash.

See p. 2, first column, lines 67-70.

Given the teaching of the Rowe sheet soap having 0.51 mm thickness, making a sheet soap of 1.5 –7 mm thickness would have been obvious to one of ordinary skill in the art. It would have been obvious to the skilled artisan to make thicker sheet soap as motivated by Rowe because of the expectation of successfully producing more supply of soap per sheet.

Claims 30 and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowe as applied to claims 1-21, 23-29, 31-33, 38-44 above, and further in view of Oneto et al. (US 4130497).

Oneto teaches that water temperature of 35-38 °C (95-100 °F) used in personal cleansing. See Experiment 3. The reference teaches personal cleansing composition for bath product, and further teaches to make shampoo composition as an alternative. See col. 4, lines 35 – 41.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Rowe method to cleanse hair with the detergent composition, as motivated by Oneto, because 1) both Rowe and Oneto are directed to personal cleansing composition art; 2) Oneto suggests that the skilled artisan would have envisioned making hair detergent formulation from the bath/shower products disclosed in Rowe.

### **Conclusion**


No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu  
Patent Examiner

  
SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER